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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,998	03/11/2004	Stanislav M. Snaidr	000417.00019	4647
22907	7590	11/14/2008	EXAMINER	
BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			LOPEZ, CARLOS N	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			11/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/796,998	SNAIDR ET AL.	
	Examiner	Art Unit	
	CARLOS LOPEZ	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 October 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10 and 11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 10 and 11 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 11 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/10/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 10 and 11 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Valdez (US 4,685,477). Valdez discloses cigar or cigarette holder capable of receiving a cigar or cigarette and for filtering smoke generated from the cigar or cigarette. The holder has three chambers. The first chamber defined by the space between a perforated tubular member, concentrically situated around a perforated inner tubular member, and the inner tubular member. The first chamber is substantially filled with a filter material. The second and third chambers are within the inner tubular member, substantially

coaxially aligned and separated by a wall having an aperture to transfer ash from the second chamber to the third chamber. The claimed non-combustible tubular member is deemed as element 25, which as noted in Col. 3, lines 10 made be made of porcelain, a known ceramic, which is non-combustible. Element 25 as shown in figure 3 encases the tobacco charge which is deemed as the tobacco rod 14. In regards to claim 11, the perforation 26 provide for the claimed porosity.

As noted by Valdez, the plurality of air intake spaces, perforations 26, is useful for enabling the ember end of the cigar or cigarette to burn. As the smoker puffs or draws on the primary smoke filter end of the cigar or cigarette, air may be drawn into the second and third chambers through the air intake spaces to enable the ember to burn. In this manner, sufficient air is provided for burning of the tobacco to generate smoke. Valdez teaches that varying the size and/or number of the air intake spaces to control the rate at which the ember end of the cigar or cigarette burns is possible. In this manner, the cigar or cigarette may be made to burn slower and therefore last longer than if smoked without the use of Valdez device. Thus the perforations 26, as noted by Valdez, reduces the free-burning rate of the burning tobacco in order to increase the number of puffs from the burning tobacco charge as instantly claimed by applicant.

In view that the tubular member 25 has a certain porosity as determined by the size and number of perforations 26, the sidestream smoke is minimized when compared to a cigarette not enclosed by the tubular member 25 of Valdez.

Moreover, in view that the Valdez provides the claimed structural limitations as recited in device claims 10 and 11, it would be obvious to a person of ordinary skill in the art as noted above to have met the claimed functions.

Alternatively, Valdez inherently provides the claimed features recited in claims 10-11 by encapsulating a cigarette with glass material having a specified number of perforations and perforation size. The encapsulation of the cigarette inherently minimizes the amount of sidestream smoke and at the same time reduce the free burn rate of the cigarette, due to less air being supplied to the burning cigarette, in order to increase the number of puffs from the burning tobacco charge as instantly claimed.

Claim 10 and 11 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 06-052497 ('497). '497 discloses cigar or cigarette holder capable of receiving a cigar or cigarette. The holder comprises a glass stowage element 2, deemed to be a ceramic material¹, which encases an effective amount of tobacco charge as shown in figures 1 and 2. The stowage ceramic element comprises of fine pores 8, thus allowing for the reduction of the claimed side-stream smoke and restricting the inflow of air to thus reduce the free-burn rate of the burning tobacco.

In view that the tubular member 2 has a porosity as determined by the size and number of pores 8, the sidestream smoke is minimized when compared to a cigarette not enclosed by the tubular member of '497. Moreover, in view that the Valdez

provides the claimed structural limitations as recited in device claims 10 and 11, it would be obvious to a person of ordinary skill in the art as noted above to have met the claimed functions.

Alternatively, '497 inherently provides the claimed features recited in claims 10-11 by encapsulating a cigarette with glass material having a specified number of perforations and perforation size. The encapsulation of the cigarette inherently minimizes the amount of sidestream smoke while reducing the free burn rate of the cigarette due to less air being supplied to the burning cigarette.

Response to Arguments

Applicant's arguments filed 7/6/07 have been fully considered but they are not persuasive. Applicant argues that Valdez's pores are "air outlets means" and therefore can't meet the claimed functions recited in the pending claims.

The instant claims require pores on a "tubular material...having means for both minimizing sidestream smoke...and reducing free-burn rate."

As previously noted, the MPEP 2114 notes the following:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed

¹ The term ceramic is a generic term encompassing materials such as glass, enamel, concrete, cement, pottery, brick, porcelain, and chinaware.

apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

“Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).”

Applicant has not provided any structural differences between Valdez and Applicant’s claimed invention. Applicant incorrectly emphasizes distinction by function when in fact applicant should be distinguishing the claimed invention by structural features.

In the instant case, applicant’s claimed function of reduction of the burn rate and side-stream smoke is achieved by enclosing the cigarette in a tubular member having a predetermined number of pores. Similarly Valdez meets the claimed structural limitations and therefore there is a *prima facie* case of obviousness that the claimed functions would be met by Valdez.

Applicant also points out that the *In re Schreiber* is being misapplied to the facts of the instant application because the opinion was based an inherency rejection. Applicant then states that the instant rejection is not an inherency rejection. Applicant’s argument is unpersuasive. The rejections noted above and in the previous office action contained both a 103 obviousness rejection and a 102 anticipation based on inherency (see the underlined text of the Valdez rejection).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/
Primary Examiner
Art Unit 1791

Application Number 	Application/Control No.	Applicant(s)/Patent under Reexamination
	10/796,998 Examiner CARLOS LOPEZ	SNAIDR ET AL. Art Unit 1791